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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,029	09/24/2003	Takayuki Suzuki	17053	4550
23389 7590 01/10/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
			EXAMINER NGUYEN, TUAN VAN	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/670,029		SUZUKI, TAKAYUKI	
	Examiner		Art Unit	
	Tuan V. Nguyen		3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 8, 9 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 7, 10 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In previous Office Action, claims 1-15 are pending; claims 1, 6, 7, and 10 were examined and rejected; and claims 2-5, 8-9, and 11-15 have been withdrawn.

Amendment After Non-Final Rejection

1. According to the Amendment After Non-Final Rejection applicants filed on October 5, 2007, claims 16-21 were added. Now, claims 1, 6, 7, 10, and 16-21 are presented for examination.

Response to Amendment

2. According to the Amendment After Non-Final Rejection applicants filed on October 5, 2007, Examiner acknowledges that: (1) the specification was corrected to overcome the previous objection therefore, the objection is hereby withdrawn; (2) claim 10 was corrected to overcome the previous objection therefore, the objection is hereby withdrawn.
3. Applicant's arguments filed on October 5, 2007 with respect to claims 1 and 10 have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21 recites "wherein the pair of junctions disposed about the first rocking axis are formed integrally with the parallel flat portions so as not to project into a bore of the distal end portion" is unclear. Examiner understood that applicant intended to claim another of junctions, which is different from a pair of junctions as claimed in claim 1, that disposed about the first rocking axis which are the pins 22a and 22b as shown in Fig. 2B of this instant application because only pins 22a and 22b are integrally formed with the flat portion 15a and 15b, respectively, and so as not to project into a bore of the distal end portion. Appropriate correction is required. Further, examiner understood that applicant intend to claim a pair of junction as claimed in claim 1 are the pins 23a and 23b that connected wires 9a and 9b, respectively as shown in Figs. 2A and 2B and will be considered as such for examination purpose.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 1, 6, 7, 16, 17 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Suzuki (JP02000279418A).**

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8. Referring to claim 1, Suzuki discloses (see Figs. 15-16 and 2, 3, 4, and 5a-5d) an medical instrument comprising: a swingable operating section 12a, 12b formed of a pair of forceps which rock around a first rocking axis defined by pins 22a, 22b ; a tubular sheath 4 having a distal end portion situated on a proximal end side of the operating section, the distal end portion having a circular-section portion having a circular cross section perpendicular to a longitudinal central axis thereof and a pair of symmetrical flat portions 15a, 15b formed by cutting the opposite sides of the circular-section portion and in sliding contact with respective proximal end portions of the forceps; a pair of wire or manipulator 101 which advances and retreats in the longitudinal direction of the sheath, thereby rocking the forceps around the first rocking axis; and a pair of junctions 100, which connected the manipulator for rocking motion around a second rocking axis, which defined by pins 103a, 103b, the junctions being situated substantially on a reference plane passing through the longitudinal central axis of the sheath and extending parallel to the second rocking axis when the operating section is closed and open.
9. Referring to **claims 6 and 7**, Suzuki (see Figs. 15-16) pins 22a, 22b, defined the first rocking axis, includes a shank and wherein the shank having a spread portion (juxtapose to the oval tube 9) formed on one of the ends of the pin that having a larger in outer diameter than the shank portion.

Claim Rejections - 35 USC § 103

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.**

13. Referring to claim 18, Suzuki discloses the invention substantially as claimed except for specifically discloses the wires are made from stainless spring steel and superelastic alloy. Examiner takes an official notice that the actuating wire or actuating rod in an endoscopic forceps are made from stainless spring steel and superelastic alloy is old and well known in the art. Extrinsic evidence, US Patent No. 6,689,122 issued to Yamamoto (see col. 6, lines 35-40).

14. **Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Townsend et al (US 6,066,102).**

15. Referring to **claims 10 and 21**, examiner understood that applicant intended to claim a pair of junctions which are the pins 23a as shown in Fig. 2B of this instant application and considered as such for the examination purposes. The device of Suzuki discloses the invention substantially as claimed except for specifically discloses that the pins that securing the forceps to the distal end portion of the tubular sheath are not to project into the bore of the distal end portion. However, Townsend discloses such a feature. Townsend discloses (see Figs. 4a-4b) housing 60 connected to tubular member, wherein the tubular member includes access lumen 28 provides access for optical fiber 900 or fluid (see col. 6, lines 37-50) and the housing 60 further includes cam pins 68 are integral with the flats 66 of the housing (see col. 6, line 57 to col. 7, line 7). Figure 4b of Townsend's drawings clearly shown that the pins are not enter into the bore of the housing 60, apparently for the purpose of eliminating interference between the pins and optical fiber or improving of the flow of fluid. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the design of the pins as disclosed by Townsend into the device of Suzuki so that it too would have the same advantage.
16. **Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Suzuki (US 6,110,127).**
17. The device of Suzuki (JP02000279418A) discloses the invention substantially as claimed except for the distal end portion of the tubular sheath is outwardly open. However, Suzuki (US 6,110,127) discloses such a feature. Suzuki discloses (see Figs. 16A and 17-19) an endoscopic device comprising, among other things, a

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distal unit 15 has a storage tube 22, wherein the storage tube provide a storage space 22a. Apparently that the storage space is outwardly open for the purpose of storing tissue samples. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate this design into the distal end of Suzuki device (JP02000279418A) so that it too would have the same advantage.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
December 21, 2007


(JACKIE) TAN-UYEN HO
SUPERVISORY PATENT EXAMINER